REMARKS

Status of Claims

Claims 1-13 are pending in the present application. Claim 14 was previously canceled. No additional claims fee is believed to be due.

Independent Claim 1 is currently amended to overcome the written recite weight percentages of the various components as well clarifying that at least 10% of the droplets are greater than 40 microns. Support for these changes is found on page 5, lines 1-3; page 7, lines 17-19, page 12, lines 2-4; and the Examples. It is believed these changes do not involve any introduction of new matter. Consequently, entry of these changes is believed to be in order and is respectfully requested.

Rejection under 35 USC §112, First Paragraph

Claim 1 stands rejected under 35 USC §112, first paragraph, as failing to comply with the written description. The Office alleges on page 2 of the Office Action that Claim 1 contains subject matter which was not described in the Specification (at the bottom of page 11) in such a way as to reasonably convey to one skilled in the relevant art that the inventors, at the time the application was filed, had possession of the claimed invention.

Applicants currently amend Claim 1 to overcome this rejection. Claim 1 now recites "wherein at least 10% of the droplets are greater than 40 microns." Accordingly, it is believed that this rejection has been overcome and Applicants respectfully request reconsideration and withdrawal of this §112, first paragraph rejection.

Rejection Under 35 USC §103(a) Over Tachibana in view of Tchinnis

Claims 1-10 and 12-13 stand rejected under 35 USC §103(a) as being unpatentable over Tachibana *et al.* (US 5,412,004) in view of Tchinnis (US 6,379,682). This rejection is respectfully traversed. First, Applicants respectfully submit that the Tachibana and Tchinnis references are improperly combined. Second, Applicants respectfully submit that the subject matter recited in the pending claims is not obvious over the combined disclosures of the applied prior art.

Applicants respectfully submit that an ordinarily skilled artisan, after reading the Tachibana and Tchinnis references, would not have the requisite motivation to use droplet

size distribution range of the discontinuous range and create the composition Applicants claim. The § 103(a) rejections set forth in the action are a hindsight reconstruction of the prior art, impermissibly based on Applicants' disclosure (and not on only the knowledge which was within the level of ordinary skill in the art at least as of the application's effective filing date).[1]

The asserted rationale supporting the § 103(a) rejections on this combination of prior art does not apply absent sound findings that the skilled artisan would have been motivated to combine the prior art to achieve the claimed invention.[2] Moreover, the mere fact that the applied prior art can be combined or modified does not render the resultant combination obvious unless the results would have been predictable to the ordinarily skilled artisan.[3] There is simply no reasonable expectation of predictably achieving success by simply reading the Tachibana and Tchinnis combination of references. The precise combination of prior art is hindsight reconstruction, impermissibly based on Applicants' disclosure. The Office provides no evidence that the hindsight reconstruction used to reject the claims here (a) takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and (b) does not include knowledge gleaned only from Applicants' disclosure. The Board of Patent Appeals and Interferences emphasized that examiners must still give strong reasons for their rejections.[4]

Neither Tachibana nor Tchinnis provides a person having ordinary skill in the art with the motivation to select particular components from Tachibana (*e.g.*, emulsifying crosslinked siloxane elastomers) for combination with a particular element from Tchinnis

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[1] *See* Board of Patent Appeals and Interferences decision on December 14, 2009 re: U.S. App. 11/135,244: "The Examiner has not established that one of ordinary skill in the art would have had a reason to coat silicone fibril-coated metal oxide particles with an additional hydrophobic coating, and to combine the coated particles with a cross-linked, non-emulsifying organopolysiloxane elastomer."

[2] *See* MPEP § 2143 (G).

[3] *See KSR Int'l,* 127 S.Ct. at 1740.

[4] *See* Board of Patent Appeals and Interferences decision on May 10, 2007 re: U.S. App. 09/757,913: "After carefully considering both the Chen and Maggenti references, we find no specific teaching or suggestion within either reference that fairly meets the language of the claim that requires 'stopping the context information updating. . .,' and 'taking a snapshot of the compression and decompression context information . . .' (claim 1). We find that to affirm the Examiner on this record would require speculation on our part... Because we find the combination of Chen and Maggenti fails to teach or suggest all the limitations recited in the claim, we agree with Appellants that the Examiner has failed to meet the burden of presenting a prima facie case of obviousness. Accordingly, we will reverse the Examiner's rejection of independent claim 1 as being unpatentable over Chen in view of Maggenti."

(*e.g.*, droplet size of discontinuous range) to form a cosmetic composition, as opposed to combining numerous other ingredients disclosed in these references. The only disclosure combining the claimed features is Applicants' specification and claims.

The asserted rationale supporting the § 103(a) rejection on this combination of prior art does not apply absent sound findings that the skilled artisan would have been motivated to combine the prior art to achieve the claimed invention.[5] Moreover, the mere fact that the applied prior art can be combined or modified does not render the resultant combination obvious unless the results would have been predictable to the ordinarily skilled artisan.[6] There is simply no reasonable expectation of predictably achieving success by simply reading the Tachibana-Tchinnis combination of references.

Assuming, *arguendo*, that the Tachibana and Tchinnis references are properly combined, Applicants respectfully submit that the subject matter recited in the pending claims is not obvious over the combined Tachibana-Tchinnis disclosures. The Office states that Tachibana does not teach the droplet size distribution range of the discontinuous range and the average particle size of the emulsifying crosslinked silicone elastomer. The Office relies on Tchinnis to teach that the droplet size of the discontinuous phase is a function of the emulsifier and its concentration used in an emulsion, and may also be affected by the process of making the emulsion.

Applicants currently amend Claim 1 to recite that at least 10% of the droplets be greater than 40 microns, in addition to the average droplet size being between 0.1 and 100 microns. Further, Claim 1 is amended to limit the components to specific weight amounts. As amended herein, the droplet size of the present claims is not taught by Tchinnis. Moreover, the claimed droplet size would violate the teachings of Tchinnis, which *requires* that *all* particles be less than 1 micron (and preferably less than 800nm).[7]

Accordingly, Tchinnis does not make up for the deficiencies of Tachibana. Moreover in response to a prior Office Action, Applicants submitted the November 2, 2007 Sunkel Declaration, made pursuant to 37 CFR 1.132. Sunkel asserts that it is not within the ordinary skill in the art to select the droplet size and particle size disclosed in the claimed composition. A formulator needs prior knowledge of the physical dimensions

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[5] *See* MPEP § 2143(G).
[6] *See KSR Int'l,* 127 S.Ct. at 1740.
[7] *See* Tchinnis, *e.g.*, Abstract; col. 3, lines 45-5; and all of the claims.

of the emulsifying composition he or she is working with and cannot rely on mixing or agitation energy, for example, to formulate within a given droplet size, because with large emulsifying silicone gel particles, no matter how much or how strong the mixing, ultimately droplets are going to coalesce to a size that the gels can stabilize by packing around the drop.[8] The claimed particle size and distribution of the stable multiphase emulsion composition influence not only droplet size, but also sensory benefits. Thus, these features are critical to the present composition; they are not simply optimal parameters one of ordinary skill in the art would select. The Applicants hope that the Examiner will find the Sunkel Declaration more persuasive in light of the present amendments.

Further, the present specification is replete with explanations why the droplet size is critical to the present invention, which explanations are diametrically opposed to the small droplet size taught in Tchinnis. For example:

> The discontinuous phase, preferably, forms droplets having a droplet size distribution range of from about 0.1 microns to about 100 microns. More preferably the discontinuous phase droplets have a droplet size distribution range such that at least 20%, preferably 15%, more preferably 10% of the droplets have a droplet size of greater than 40 microns, more preferably greater than 60 microns, most preferably greater than 75 microns, and optimally greater than 40 microns.[9]

Tachibana neither identifies a need to prevent agglomeration of the solid particles in a cosmetic product or upon application to the skin, such as in fine lines and wrinkles, nor does Tachibana disclose a manner of accomplishing the same. Tachibana simply addresses the need to increase viscosity of a composition. Thus, there is no motivation or suggestion to modify the Tachibana composition to arrive at the claimed composition.

Applicants respectfully submit that the Tachibana and Tchinnis references are improperly combined, or, alternatively, the Tachibana-Tchinnis combination does not render obvious Applicants' claimed subject matter. In view of the above, Applicants submit that Claim 1, and the claims depending therefrom, are patentably distinct from Tachibana in view of Tchinnis and Applicants request withdrawal of the rejection. Accordingly, Applicants respectfully request reconsideration and withdrawal of the Section 103 rejection.

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[8] *See* Sunkel Declaration, page 2.

Rejection Under 35 USC §103(a) Over Tachibana in view of Tchinnis and Hawley

Claim 11 stands rejected under 35 USC §103(a) as being unpatentable over Tachibana in view of Tchinnis as applied to Claims 1-10 and 12-13 as above, and further in view of Hawley, G.G., The Condensed Chemical Dictionary, 10th Ed., Van Nostrand Reinhold Co., New York (1981), pages 121, 385, 434, and 686 (hereafter "Hawley"). This rejection is respectfully traversed. First, as argued above, Applicants respectfully submit that the Tachibana and Tchinnis references are improperly combined. Adding an additional reference to the Tachibana-Tchinnis combination does not overcome this problem. Second, Applicants respectfully submit that the subject matter recited in the pending claims is not obvious over the combined disclosures of the applied prior art.

The Office believes that Hawley teaches the preservatives that are lacking in the disclosures of Tachibana and Tchinnis and it would have been obvious to one of ordinary skill in the art at the time of the invention to add any one of the preservatives disclosed in Hawley to the composition of Tachibana and Tchinnis for their known antimicrobial effects. Applicants respectfully traverse this rejection as the combined references do not teach or suggest all of the claim limitations.

The Office Action does not establish a *prima facie* case because, as explained above, the combination of Tachibana and Tchinnis fails to disclose the requisite limitations of Applicants' invention that deal with droplet size distribution. The mere addition of Hawley's disclosure of commonly used preservatives fails to remedy this shortcoming. Accordingly, Applicants respectfully assert that Hawley's disclosure of alleged well-known preservatives when viewed in combination with Tachibana and Tchinnis would not have rendered Applicants' invention obvious since none of the benefits of the claimed composition are taught, suggested, or even recognized by the combination of references.

Applicants respectfully submit that the Tachibana and Tchinnis and Hawley references are improperly combined, or, alternatively, the Tachibana-Tchinnis-Hawley combination does not render obvious Applicants' claimed subject matter. In view of the above, Applicants submit that Claim 11 is patentably distinct from Tachibana in view of Tchinnis and in further view of Hawley and Applicants request withdrawal of the

[9] *See* specification page 11, line 30 – page 12, line 2.

rejection. Accordingly, Applicants respectfully request reconsideration and withdrawal of the Section 103 rejection.

Conclusion

Applicants have made an earnest effort to place the present application in proper form and to distinguish the invention as claimed from the applied references. In view of the foregoing, Applicants respectfully request entry of the amendments presented herein, reconsideration of this application, and allowance of the pending claims.

Respectfully submitted,
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